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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/824,402

04/15/2004

Youichi Akasaka

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04/11/2006

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EXAMINER

DIACOU, ARI M

ART UNIT

PAPER NUMBER

3663

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/824,402	AKASAKA ET AL.	
	Examiner	Art Unit	
	Ari M. Diacou	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-34 and 39-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-38 is/are rejected.
- 7) ☒ Claim(s) 35, 37, 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4-15-2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 20-34 and 39-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **with** traverse in the reply filed on 3-23-2006.
2. Claims 1-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **with** traverse in the reply filed on 3-23-2006.
3. The claims 1-19 are withdrawn because they are directed towards a species with an EDFA before and after the Raman amplifying medium [page 55 lines 14-16 of claims submitted 4-15-2004], reading on species B-D (depicted in figures 8-11). The species elected (A: figure 7) had no EDFA at the input.
4. The applicant traversed the restriction on the grounds that is posed no serious burden to the examiner. This point is moot since the propriety of the restriction is evidenced by the different classifications of the respective inventions.

Information Disclosure Statement

5. The information disclosure statement filed 4-15-2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the

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application file, but the information referred to therein has not been considered. Those references not considered have been struck through on the IDS.

Claim Objections

6. Claim 35, 37 and 38 are objected to because of the following informalities: the claim contains acronyms (EDFA, SMF). It should either be replaced with the unabbreviated terminology or should include an indication of what the applicant intends to cover. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Masuda et al. (NPL on PTO-892).

- Regarding claim 35, Masuda discloses a wavelength division multiplexed light optical amplifier, comprising:
 - an optical fiber configured to be a Raman amplifying medium; [Fig. 1 (between A and B)]
 - a plurality of pump lights; [Fig. 1, pumps are marked LD]
 - at least one EDFA; [Fig. 1, EDF 1]
 - means for injecting the plurality of pump lights to the optical fiber; and [Fig. 1, CIR]
 - means for controlling the plurality of pump lights to adjust at least one of a wavelength-dependent loss characteristic of the optical fiber and a wavelength-dependent noise characteristic of the optical fiber. [Fig. 2] [Page 754, Col. 1, lines 2-4]
- Regarding claim 37, Masuda discloses a wavelength division multiplex optical signal repeater, comprising:

- an optical fiber configured to be a Raman amplifying medium; [Fig. 1 (between A and B)]
 - a plurality of pump lights; [Fig. 1, pumps are marked LD]
 - at least one EDFA; [Fig. 1, EDF 1]
 - means for providing a pump light from the plurality of pumping light sources to the optical fiber; and [Fig. 1, CIR]
 - means for wavelength-dependent amplifying the wavelength division multiplex optical signal with at least one of the plurality of pump lights and an EDFA connected in series with the optical fiber. [Fig. 2] [Page 754, Col. 1, lines 2-4]
- Regarding claims 36 and 38, Masuda discloses the amplifier of claim 35 or 38, wherein: the amplifying medium comprises at least one of a single mode fiber and a dispersion compensation fiber.

10. Claims 35-38 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Masuda et al. (USP 6,172,803). This patent seems to be the same invention that was disclosed in the Masuda NPL reference.

Conclusion

1. While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

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2. The references made herein are done so for the convenience of the applicant. They are in no way intended to be limiting. The prior art should be considered in its entirety.
3. The prior art which is cited but not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ari M. Diacou whose telephone number is (571) 272-5591. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMD 4/6/2006



RICARDO PALABRICA
Primary Examiner
AU 3663